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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/003,562

10/24/2001

Emmanuele Giacobbi

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06/02/2004

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EXAMINER

CHAUDHRY, SAIED T

ART UNIT

PAPER NUMBER

1746

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,562

Applicant(s)

GIACOBBI ET AL.

Examiner

Saeed T Chaudhry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 3-19 and 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 20-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.65(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION**Election/Restriction**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, Claims 1-2, and 20-22, drawn to a process of applying a protective coating and removing coating with a cleaning solution, classified in Class 134, subclass 4.

Group II, Claims 3-19, drawn to a method of protecting a surface by applying a composition comprising a fluorinated compound, classified in Class 427, subclass 154.

Group III, Claims 23-30, drawn to a composition comprising a fluorinated compound and a fluorosurfactant, classified in class 510, subclass 367.

The inventions are distinct, each from the other because:

Inventions (I, II) and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as non-fluorinated compound or the product as claimed can be used in a materially different process such as dry clean clothes.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group II, claims 3-19 do not require removing the coated surface with a cleaning treatment.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter, the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Jeffrey V. Bamber on March 10, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-2 and 20-22. Affirmation of this election must be made by applicant in responding to this Office action. Claims 3-19 and 23-30 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Joint Inventors

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

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Claims 1-2 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Norman et al.

Norman et al (4,347,2660) disclose a method of treating surface such as automobile by spraying a polymer protective coating contains fluorinated surfactant. The coating also contains silicone surfactant. The protective coating is removed from the surface after exposure to soiling conditions with water (see abstract and claims).

A feature of the Norman et al invention is the fact that the articles to be protected do not have to have their surfaces cleaned before the protective film is applied. Indeed the aqueous film-forming solution wets an automobile surface better when that surface is covered with road dust as compared to when that surface is perfectly clean. Moreover the flushing off of the water-dispersible film removes considerable road dust and the like so that the protected surface is significantly cleaned by the treatment of the present invention.

In order to effectively cover water-repellent surfaces such as heavily waxed or polished automobile exteriors, the film-forming coatings should contain a significant amount of leveling agent. Thus about 0.02% to about 1% of fluorinated surfactant enables the film to be applied to a large automobile by a very brief spray treatment taking only a few minutes. The film so applied is self-leveling and will spread to cover the entire automobile surface even if the automobile's exterior paint is well waxed and shined, or has a shined silicone polish coating (see col. 1, lines 42-51).

The pre-coat of the present invention, when applied to a window, can make it difficult to see clearly through the window. It is accordingly helpful to leave some window area uncoated where the automobile is to be driven from the pre-coat station to the asphalt-applying station or

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from the asphalt-applying station. Rolling down a window of the automobile after the window has been pre-coated will generally cause some of that pre-coat to be scraped from the window by the weatherstrip normally engaging its lower portion. Windows are readily cleaned of any asphalt overspray they may receive, as by a dab with a kerosene-wetted cloth (see col. 3, lines 21-32).

The reference fails to specify indoor household surface.

It would have been obvious at the time applicant invented the claimed process to utilize Norman et al process of applying a protective coating on a surface such as automobile surface including window of automobile and then removing the coating with water for the purpose of protecting and cleaning indoor household surfaces. Since windows of the automobile are glass and indoor household includes glass surfaces. One of ordinary skill in the art would use the Norman et al process for cleaning and protecting the indoor house hold surfaces form dust and other contaminants. Norman et al disclose that solvent such as kerosene may be used to remove coating and asphalt overspray. Therefore, Norman et al meet the claim 20 limitations.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al in view of Shank.

Norman et al were discussed supra. However, the reference fails to disclose fluorinated solvent as a cleaning agent for removing protective coating.

Shank (6,478,880) disclose a method for cleaning fluorinated oils (coating) from surfaces by contacting a composition comprising fluorinated compound and fluorinated aromatic compound (see abstract, and claims)

It would have been obvious at the time applicant invented the claimed process to use fluorinated compound as a solvent as disclosed by Shank in the process of Norman et al for the

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purpose of removing coating because Shank disclose that fluorinated compound composition serve as a solvent cleaners for fluorinated oils (coating). Therefore, one of ordinary skill in the art would have reasonable expectation that fluorinated compound composition would remove protective coating from the household surfaces, which is contaminated with dust and the like as Norman et al remove protective coating and asphalt overspray with kerosene solvent after coating is contaminated.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al in view of Shank as applied to claim 21 above, and further in view of Silvani et al.

Norman et al and Shank were discussed supra. However, the references fail to disclose (per)fluoropolyether as a fluorinated compound.

Silvani et al (6,262,006) disclose solvent comprising perfluoropolyether for removing traces of oils, greases, waxes (see abstract and col. 1, lines 6-14).

It would have been obvious at the time applicant invented the claimed process to utilize perfluoropolyether as disclosed by Silvani et al for removing coating such as oil in the process of Norman et al for the purpose of removing coating from the household surfaces. One of ordinary skill in the art would have reasonable expectation that perfluoropolyether would remove protective coating from the household surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeed T. Chaudhry whose telephone number is (571) 272-1298. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Randy Gulakowski, can be reached on (571)-272-1302. The fax phone number for non-final is (703)-872-9306.

When filing a FAX in Gp 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are for entry into the file of the application. This will expedite processing of your papers.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1700.

Saeed T. Chaudhry

May 14, 2004


RYSZARD SLAKOWSKI
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